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In re Application of WOOLFE et al.
Application No.: 10/516,943
PCT No.: PCT/GB03/02669
Int. Filing: 20 June 2003
Priority Date: 22 June 2002
Attorney Docket No.: 00303/US
For: PHARMACEUTICAL COMPOSITION

: DECISION ON
: RENEWED PETITION
: UNDER 37 CFR 1.47(a)

This is a decision on applicant's renewed petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 06 August 2007, to accept the application without the signatures of joint inventors, Jacqueline Yvonne Allen and Mark Clifford Elliott. Applicant's request for a three month extension of time is granted.

BACKGROUND

On 17 November 2005, applicant filed a petition under 37 CFR 1.47(a), along with a declaration, executed by the joint inventors on behalf of the nonsigning inventors. The petition under 37 CFR 1.47(a), in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), requested the acceptance of the application without the signatures of inventors Jacqueline Yvonne Allen and Mark Clifford Elliott, alleging that Ms. Allen refuses to sign the application and Mr. Elliott is unavailable.

On 24 February 2006, a decision dismissing the petition under 37 CFR 1.47(a) was mailed to applicant indicating that Petitioner had not provided evidence that a complete copy of the application papers, including specification, claims and drawings and declaration, were provided to Ms. Allen and that diligent efforts to locate Mr. Elliott were not pursued and documented.

On 26 June 2006, applicant filed a renewed petition under 37 CFR 1.47(a) with a request for a two month extension of time. On 2 October 2006, a decision dismissing the petition was mailed indicating that Petitioner had provided sufficient evidence of Ms. Allen's refusal to sign but had not furnished sufficient evidence to conclude that Mr. Elliott refused to sign the

application papers or was unavailable.

On 4 December 2006, applicant filed a renewed petition under 37 CFR 1.47(a). On 05 March 2007, a decision dismissing the petition indicating that "diligent efforts" were not made to contact the nonsigning inventor Mark Clifford Elliott using Internet searches and the correct spelling of his name.

On 06 August 2007, applicant filed a renewed petition under 37 CFR 1.47(a).

DISCUSSION

As previously stated, a petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1), (3) and (4) were previously satisfied. Item (2) above was previously satisfied with respect to nonsigning inventor, Jacqueline Yvonne Allen.

Unavailability of Inventor Elliott

With respect to counsel's inability to find or reach Mr. Elliott, Petitioner now present the affidavit of Samantha Claire Radley. Ms. Radley's affidavit states that she conducted a Internet search for Mr. Elliott without success. She also contacted his former employer to obtain an updated address and was advised that the last known address for Mr. Elliott had not changed. Ms. Radley was apprised that an employment reference had been made on behalf of Mr. Elliott by SRG Limited. Ms. Radley contacted Glen Harris of SRG Limited. According to Ms. Radley, Mr Harris attempted to contact Mr. Elliott by telephone and email without success. Ms. Radley also contacted the United Kingdom Post Office customer services department, which confirmed Mr. Elliott's last known address. The United Kingdom Post Office did not have any redirection advice for Mr. Elliott.

Sufficient diligent efforts to locate Mr. Elliott were pursued and documented, such as Internet searches, E-mail contact to obtain a current address, contact with his former employer and a former colleague in search of a forwarding address and a request from the Postal Service for his forwarding address. Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a "diligent effort" was made. Petitioner had submitted a statement of facts under 37 CFR 1.47(a) indicating that a further search for Mr. Elliott's new address was made. The attempts to locate inventor Elliott were sufficient to conclude that "a diligent effort" was made to locate the non-signing inventor. The action taken by petitioner is sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor. Under these circumstances, it can now be concluded that Mr. Elliott is unavailable to sign the application.

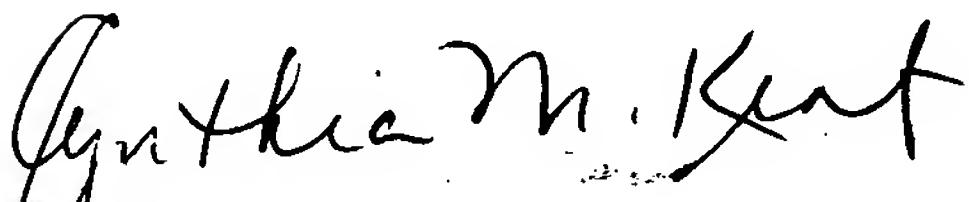
In sum, Petitioner has now satisfied Items (1) - (4) above. Petitioner has submitted sufficient evidence with respect to Mr. Elliott, that is, that "diligent efforts" were made to contact the nonsigning inventor Mark Clifford Elliott and that Jacqueline Yvonne Allen refuses to sign the application papers. Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **GRANTED**.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 17 November 2005. The application has an international filing date of 20 June 2003 under 35 U.S.C. 363, and a date of 17 November 2005 under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventors at their respective last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.



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